

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appeal No. 2007-1446	:	
	:	
In re application of	:	
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CHRISTOPHER S. NOLAN	:	
	:	
Serial No. 09/684,032	:	Group Art Unit: 3652
	:	
Filed: October 6, 2000	:	Examiner: Charles A. Fox
	:	
For: LINER FOR CONTAINER	:	
WITH SIDE DOOR	:	

REQUEST FOR REHEARING

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 C.F.R. 41.52, Appellant respectfully requests a rehearing of the Decision On Appeal mailed by the Board on December 19, 2007. Appellant believes the following points were misapprehended or overlooked by the Board.

I. THE INVENTIONS OF CLAIMS 1,2, 5, AND 6 ARE NOT ANTICIPATED BY THE '284 PATENT

The Board affirmed the rejection of claims 1, 2, 5, and 6 under 35 U.S.C. § 102(b) as being anticipated in view of U.S. Patent No. 3,951,284 to Fell et al. (the "'284 Patent"). The Board's position relies entirely on the following statement in the '284 Patent:

it will be apparent to those skilled in the art that a similar type liner could be applied to a shipping vehicle having side walls, and opening doors in at least one of the walls, the shipping vehicle could be a box trailer, a van or truck body and in the case of rail transport, a freight car.

'284 Patent, Col. 8, ll. 29-34.

As Federal Circuit precedent establishes, “[a]nticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention.” *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385 (Fed. Cir. 1984); *see also Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991) (holding that for a finding of anticipation, “[t]here must be no difference between the claimed invention and the reference disclosure . . .”). This Board’s precedent is entirely consistent with this “strict identity” approach. *See Ex parte Standish*, 10 USPQ2d 1454, 1457 (Bd. Pat. Ap. & Int’f 1989) (“anticipation of a claimed product cannot be predicated on mere conjecture as to the characteristics of a prior art product.”).

Appellant’s claim 1 requires a liner (not a shipping vehicle) having “an access opening along at least one [elongated] side panel adapted for loading and unloading said cargo.” Nowhere in the above-referenced statement or elsewhere in the ‘284 Patent is there any express disclosure of a liner having an access opening along at least one elongated side panel, as opposed to an end panel. Instead, the statement merely indicates that a “similar type” liner disclosed in the ‘284 Patent with an end opening can be used in a shipping vehicle having side walls and opening doors in at least one of the walls, ***but plainly does not state that any elongated side panel of a liner has an opening***. During prosecution, the Examiner agreed with this position on the record, admitting that the ‘284 Patent does not explicitly disclose a liner with an access opening along at least one of the side panels. *See, e.g.*,

Examiner's Answer p. 4 (“...*Fell et al. [the ‘284 Patent]* do not explicitly teach the opening in the side of the liner...”). The Board’s decision affirming the rejection curiously flies in the face of this express admission by the Examiner, without any explanation why it suddenly disagrees with the position taken by the Examiner throughout prosecution.

Appellant submits that the Examiner was correct on this point of fact. By merely stating that a “similar” liner could be used in various types of shipping vehicles, Fell simply does not provide an express disclosure of the claimed liner having an access opening along at least one elongated side panel. Specifically, the liner having an opening in an end panel described in the ‘284 Patent could be used in a shipping vehicle having opening doors along a side wall as well as an end wall, but *without also having an opening in an elongated side panel. That is, the shipping vehicles described in Fell may have opening doors in a side wall, as well as an opening in the end of the vehicle.* For example, the loading and unloading would be through the end opening (the only manner disclosed in the ‘284 Patent), and the doors in the side wall would remain closed. This enables the liner of the ‘284 Patent to be used in a container having multiple openings without having to modify the container to remove the opening door in the side wall. Stated another way, the statement of Fell relied upon by the Board merely suggests that a “similar” liner in the ‘284 Patent could *also* be used in a container having an additional door. However, contrary to the Board’s position, this statement *never* expressly describes that the *liner* actually has an access opening along at least one elongated side panel, as required by Appellant’s claims.

Summarizing, each and every limitation of the claims at issue is not present in the ‘284 Patent. There is simply no express disclosure of a *liner* having an access opening along at least one elongated side panel. Instead, there is only reference to a *shipping vehicle* having “opening doors” in some unspecified wall, which is not in any way what is being claimed. Accordingly, Appellant respectfully submits that the Board’s finding of express

anticipation is based on “mere conjecture” regarding the presence of the claimed feature in the Fell reference, and therefore cannot stand.

Given the lack of any express teaching, a proper anticipation rejection can only be based on “inherency.” However, the prerequisites for a proper finding of inherency are also lacking from the Board’s decision. Under well-established precedent, anticipation “by inherency” requires that the missing claim feature must necessarily be present in the reference. *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282, 54 USPQ2d 1673 (Fed. Cir. 2000) (“a prior art reference may anticipate without disclosing a feature of the claimed invention if that missing feature is necessarily present”) (emphasis added). ***Consequently, the mere probability or possibility that the claimed invention might result under certain circumstances is insufficient.*** *Continental Can Company USA v. Monsanto Company*, 948 F.2d 1264, 1269, 20 USPQ2d 1746 (Fed. Cir. 1991) (“Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”).

Rather than express anticipation, it is readily apparent that the “mere probability or possibility” that the liner of Fell might include another opening in an elongated side panel is the entire basis of the Board’s anticipation rejection. Specifically, the Board relies on the statement that “a similar type liner ***could*** be applied to a shipping vehicle having side walls, and opening doors in at least one of the walls, the shipping vehicle ***could*** be ... in the case of rail transport, a freight car” in affirming the anticipation rejections. The Board never points to where the missing claim feature (i.e., a liner with an access opening along at least one elongated side panel) is “necessarily” present in the Fell reference. The possibility that such an opening could be formed in the liner invented by Fell simply does not establish anticipation. Simply put, the ‘284 Patent simply does not include each and every limitation of the rejected claims, with the requisite strict identity. Thus, a reversal of the anticipation

rejections is in order.

By their dependence on claim 1, claims 2, 5, and 6 are also not anticipated. However, with specific reference to claim 6, it requires “a second access opening including a tube in the second side panel substantially opposite the first opening for also loading/unloading said cargo and a second closure for said second opening.” Nowhere does the Board point to a corresponding disclosure in the ‘284 Patent and Appellant respectfully submits that the ‘284 Patent fails to provide the same. The ‘284 Patent only discloses a liner having openings in one panel, not multiple panels. Accordingly, reversal of the anticipation rejection to this claim is in order.

**II. THE INVENTIONS OF CLAIMS 1-8 AND 12-18 ARE NOT RENDERED
OBVIOUS BY THE ‘284 PATENT TAKEN ALONE OR IN COMBINATION
WITH OTHER PATENTS**

**A. THE ‘284 PATENT TAKEN ALONE FAILS TO RENDER
THE INVENTIONS OF CLAIMS 1, 2, 13, AND 17 OBVIOUS**

Based on the Board’s affirmation of the rejection of claim 1 under 35 U.S.C. § 102(b) as being anticipated in view of the ‘284 Patent, the Board affirmed the rejection of claims 1, 2, 13, and 17 under 35 U.S.C. § 103(a) as being obvious over the ‘284 Patent. However, as explained above, the ‘284 Patent does not anticipate claim 1. Since anticipation is the sole basis for affirming the rejection of claim 1, Appellant respectfully submits that reversal of the rejection of claim 1 on obviousness grounds is in order.

Moreover, in order to establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. MPEP 2143.01 (citing *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970)). Rather than teaching or suggesting such, the inventions recited in claims 1, 2, 13, and 17 are in stark and total contrast to the liner disclosed in the ‘284 Patent, which simply does not teach a liner having an opening in an

elongated *side panel*. Rather, Fell simply provides a teaching that the “similar” liner having an opening in an end panel described in the ‘284 Patent could be used in a “shipping vehicle having side walls, and opening doors in at least one of the walls . . . ,” and nothing more.

Considering the entire teaching in the ‘284 Patent, a skilled artisan would not modify the disclosed liner to have an access opening along at least one side panel because such a modification would change the entire principle of operation. Specifically, the ‘284 Patent states that “[o]nce the container has reached its destination *some means must be provided to tilt the container.*” (at col. 7, ll. 47-48, emphasis added). If the only opening of the liner is formed in an elongated side panel, as the Board believes is taught by Fell, the desired “flow” of materials discussed in the ‘284 Patent would not occur during tilting. Rather, the material would fall against the partial wall portions that do not constitute the opening doors. Also, tilting a container sideways would potentially result in the container toppling over, clearly an undesired result. Thus, when properly considering the ‘284 Patent “as a whole,” including these critical teachings of how it “must” be used in practice, a skilled artisan would not be motivated to modify the liner to have an access opening along at least one elongated side panel, as claimed. See *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1550, 220 USPQ 303 (Fed. Cir. 1983) (stating that, “[t]he well established rule of law is that each prior art reference must be evaluated as an entirety”). This evidence of a teaching away from Appellant’s invention is simply disregarded by the Board in its analysis, which is improper.

**B. THE ‘284 PATENT TAKEN ALONE FAILS TO RENDER
THE INVENTION OF CLAIM 5 OBVIOUS**

The Board also affirmed the rejection of claim 5 under 35 U.S.C. § 103(a) as being obvious over the ‘284 Patent. The Board states that the ‘284 Patent teaches an opening in

a side panel and that a person of ordinary skill in the art at the time of the invention would appreciate that the '284 Patent "teaches a rail freight car liner having an opening that would be approximately at the mid-point of one side panel." *Ex Parte Christopher S. Nolan, Decision On Appeal, Appeal No. 2007-1446, p. 6-7.*

However, as explained above, the '284 Patent does not anticipate claim 5 and does not teach or suggest providing an opening in any elongated side panel of a liner. Moreover, the Examiner and the Board appear to take "official notice" that "rail freight cars do not have door openings in their ends and usually have openings along their mid point." *Decision on Appeal p. 7.* From this, the Board states that "we agree with the Examiner that a person of ordinary skill in the art at the time the invention was made would appreciate that Fell teaches a rail freight car liner having an opening that would be approximately at the mid-point of one side panel."

Respectfully, this rejection is based on inappropriate reliance on "common knowledge" without evidentiary support in the record. *See In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (stating that "the ***Board cannot simply reach conclusions based on its own understanding or experience—or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.***") (emphasis added). Neither the Examiner nor the Board cite any evidence teaching a liner with an opening at approximately a mid-point of a side panel, or that rail freight cars have an opening at approximately a mid-point of a side of the car. There are many configurations of rail freight cars (e.g., lorry style, coil cars, auto carriers, flatcars, gondolas, hopper cars, covered hoppers, tank cars, slate wagons, stock cars, well cars, transporter wagons, etc.), and the mere incantation of a "rail freight car" does not mean it must have a door opening along its side or a liner having an access opening along at least one elongated side panel. Since all of the limitations of claim 5 are not taught or suggested by the '284 Patent, a *prima facie* case of

obviousness has not been established. Accordingly, claim 5 should be allowed.

**C. THE ‘284 PATENT TAKEN ALONE FAILS TO RENDER
THE INVENTION OF CLAIM 6 OBVIOUS**

The Board also affirmed the rejection of claim 6 under 35 U.S.C. § 103(a) as being obvious over the ‘284 Patent. Regarding claim 6, the Board states that the ‘284 Patent “contemplates freight rail cars, and many freight cars have doors on both sides of the car.” *Ex Parte Christopher S. Nolan, Decision On Appeal, Appeal No. 2007-1446, p.8.* The Board also states that “[a] person of ordinary skill in the art would appreciate that when a liner is used in a rail freight car, the liner would have an opening approximately at the mid-point of each side of the rail freight car to allow for loading and unloading on either side of the car.” *Id.*

Similar to claim 5, the Board appears to take “official notice” regarding the presence of multiple openings in a “rail freight car.” However, no evidence whatsoever is cited to support this point. Instead, the Board respectfully makes an assumption that is unwarranted based on the evidence of record. *See In re Zurko*, 258 F.3d at 1385. There are many configurations of rail freight cars (e.g., lorry style, coil cars, auto carriers, flatcars, gondolas, hopper cars, covered hoppers, tank cars, slate wagons, stock cars, well cars, transporter wagons, etc.), and the Board’s position that “freight cars have doors on both sides” is entirely unsupported by any substantial evidence in the present record. Rather, it is based on mere speculation as to what a skilled artisan would know.

Also, the ‘284 Patent fails to teach openings in more than one panel of a liner, a point that is simply overlooked by the Board. Moreover, a skilled artisan would not be motivated to modify the liner of the ‘284 Patent to include openings in more than one panel. As mentioned above, the ‘284 Patent specifically teaches “some means must be provided to tilt the container” when it arrives at its destination. In view of this teaching and other teachings

of the '284 Patent, one would not modify the liner in the '284 Patent to include openings in more than one panel. Specifically, since tilting must be accomplished and there is only a teaching of openings in a single panel of the liner of the '284 Patent, a second opening would be detrimental. When tilting the container, some of the material within the liner would potentially exit the second opening and the user would not have control of the material. Accordingly, a *prima facie* case of obviousness is lacking and the rejection of claim 6 should be reversed.

**D. THE '284 PATENT IN COMBINATION WITH THE '906 PATENT
FAILS TO RENDER THE INVENTIONS OF CLAIMS 14 AND 18 OBVIOUS**

The Board affirmed the rejection of claims 14 and 18 under 35 U.S.C. § 103(a) as being obvious over the combination of the '284 Patent and U.S. Patent No. 4,516,906 to Krein (the "'906 Patent"). "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F. 3d 977, 988, 78 USPQ2d 1329 (Fed. Cir. 2006). In this instance, the Board fails to articulate any reasoning with some rational underpinning to support the combination of the '284 Patent with the '906 Patent.

The Board admits that the '284 Patent does not teach a liner that is free-standing. *Ex Parte Christopher S. Nolan, Decision On Appeal, Appeal No. 2007-1446, p.14*. However, the Board overlooks the elaborate connector system described in the '284 Patent. This is one of the main focuses of the '284 Patent, that is, to include a plurality of "stretchable connectors" to maintain the liner in a desired position (see Col. 2, ll. 9-40). The connector system disclosed in the '284 Patent suspends the liner from the top of the container, which is beneficial during the unloading process (that requires tilting of the container).

In contrast, the '197 Patent states that "it is important to have the liner secured against

the walls of the container. . .” Col. 2, ll. 23-24. To accomplish this, the ‘197 Patent discloses use of a plurality of “retaining members 34” comprised of a “retaining bracket 36” and “securing bar 38.” The securing bar 38 is slidably received in the retaining bracket 36 (see, e.g., Figure 14). If one were to tilt the container (as required in the ‘284 Patent) containing the liner configuration of the ‘197 Patent, the securing bar 38 would slide out of the retaining bracket, thus freeing the liner from the container. For this reason, the ‘284 Patent requires the elaborate system of stretchable connectors to maintain the liner in a desired position.

Modifying the liner in the ‘284 Patent with the liner in the ‘197 Patent (as proposed by the Examiner and Board) would also change the principle of operation of the invention in the ‘284 Patent. Specifically, the ‘284 Patent requires a liner that does not contact to the top of the container and remains in the container during tilting. Replacing the connector system of the ‘284 Patent with that taught in the ‘197 Patent would result in a liner that touched the top of the container and would fall out of the container during tilting. Since the Examiner and Board’s proposed modification would change the principle of operation of the liner in the ‘284 Patent, the teachings of the references are not sufficient to render the claims *prima facie* obvious. *See Ex parte Chicago Rawhide Manufacturing Company*, 1984 Pat. App. LEXIS 22, 223 USPQ 351(Bd. Pat. App. & Inter.1984) (this Board finding non-obviousness because the elements of the cited prior art would have to be arranged in a different manner from the arrangement cited in the prior art). Also, the Examiner and Board have failed to provide “some articulated reasoning with some rational underpinning” to support the obviousness rejection. *See In re Kahn*, 441 F. 3d at 988. Accordingly, the rejection of claims 14 and 18 is improper and should be reversed.

E. BY THEIR DEPENDENCE, CLAIMS 3, 4, 7, 8, 12, 15, AND 16 SHOULD BE ALLOWED

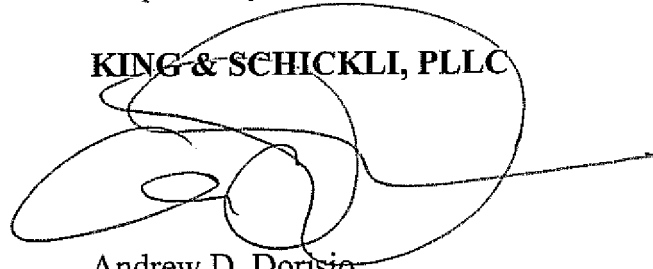
Respectfully, the Board’s affirmation of the rejection of claims 3-4, 7, 8, 12, 15, and 16 was based on an improper interpretation of the teachings of the ‘284 Patent. As discussed

above, this reference fails to in any way teach or suggest a liner having an access opening along at least one elongated side panel. Since none of the secondary references cited by the Examiner provide this necessary teaching, the rejections to claims 3, 4, 7, 8, 12, 15, and 16 should be reversed and the claims should be allowed.

In summary, Appellant has addressed and met every rejection affirmed in the Decision on Appeal and respectfully submits that all of the rejected claims meet the statutory requirements for patentability. Thus, it is respectfully requested that all outstanding rejections of claims 1-8 and 12-18 be reversed and that the present application be remanded to the examiner with instructions for immediate allowance.

Respectfully submitted,

KING & SCHICKLI, PLLC

A large, stylized handwritten signature in black ink, appearing to read 'Andrew D. Dorisio', is written over the firm name and extends to the right.

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